

### **Remarks/Argument**

#### **Claim Rejections – 35 USC 112**

1. Claims 30 and 31 are rejected under 35 USC §112, Para.2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, in that the phrase “as said depiction” is indefinite as to that to which it refers.

Claim 1, from which claims 30 and 31 directly depend, refers to one element of the invention as being, “at least one warning replica.” It is clear in the context of that claim, and from the Specification (See, e.g., page 3, lines 12-14, “An authentic life-like warning replica of a guard dog face gives realism to the present invention’s look and feel. Popular dogs associated with a preventive look could include a German Sheppard [sic Shepherd], Rottwieler [sic Rottweiler], Doberman, etc.”), that the erroneous reference to “said depiction” in claims 30 and 31 is actually a reference to that which is depicted by claim 1’s “warning replica.” Accordingly, claims 30 and 31 are corrected by replacing “depiction” with “warning replica.”

2. Claims 30 and 31 are likewise rejected under 35 USC §112, Para. 2 because the limitation “said depiction” lacks an antecedent basis. As above, it is clear that the “depiction” referred to is the warning replica’s depiction of a guard

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dog or similarly stern visage, so the correction of claims 30 and 31 discussed above, substituting "warning replica" for "depiction", also cures the antecedent basis problem regarding those two claims.

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### **Claim Rejections – 35 USC § 102**

As stated in *W. L. Gore Associates v Garlock*, 721 F.2d 1540 (Fed. Cir. 1983)

“anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration”.

*Lindemann Maschinenfabrik GMBH v American Hoist and Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984), states: “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*”

The Federal Circuit has further indicated that “in deciding the issue of anticipation, the trier of fact must identify the element of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference.” *Id.*, 221 USPQ at 485.

Further, “ [u]nder 35 U. S. C. Section 102, anticipation requires that...the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public.” *Akzo N. V. v United States Int’l. Trade Commission*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245.

Similarly, the Federal Circuit has stated: “An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of

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ordinary skill in the field of the invention.” *ATD Corp. v Lydall, Inc.*, 159 F.3d 534, 48 USPQ2d 1321, 1328 (Fed. Cir 1998).

“There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.”

*Scripps Clinic & Research Foundation v Genentech Inc.*, 927 F.2d 1471, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

“[A] device which does not operate on the same principle cannot be an anticipation.” *Los Alamitos Sugar Co. v Carroll*, 173 F2d. 280, 284 (9<sup>th</sup> Cir. 1909).

“It is not sufficient, in order to constitute an anticipation of a patented invention, that the device relied upon might, by modification, be made to accomplish the function performed by that invention, if it were not designed by its maker, nor adopted, nor actually used for the performance of such function.” *Topliff v. Topliff et al.*, 145 U. S. 156, Syllabus.

Regarding claimed anticipation under Section 102(b), *Crown Operations Int., Ltd. v. Solutia Inc.*, 289 F3d. 1357, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 1990)

holds that the single reference must describe the claimed invention, with all of its claim limitations, clearly enough to demonstrate in detail that the invention was present, and enabled, in the prior art, as recognized by persons of ordinary skill in the pertinent art. See also *In re Spada*, 911 Fed. 2d 705, 708, 15 USPQ2d 1655, 1657, Fed.Cir. 1990: “[T]he reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the

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invention in possession of it." A prior art reference must be enabling as required for US patents under 35 USC §112, first paragraph, *i.e.*, a person of ordinary skill in the art reading the reference must be able both to understand and to make the described invention. *Paperless Accounting, Inc. v Bay Area Rapid Transit Sys.*, 804 F.2d 659, 665, 231 USPQ 649, 653 (Fed. Cir. 1986).

The Federal Circuit has clarified that, to support a finding of invalidity based on anticipation, the reference asserted to be anticipating must enable the subject matter of the reference, and that of the patented invention, without undue experimentation. *Elan Pharmaceuticals Inc. v. Mayo Foundation for Medical Education and Research*, 346 F.2d 1051, 68 USPQ2d 1373, (Fed. Cir 2003)

As previously stated, the prior art reference must disclose each element of the claim "arranged as in the claim." *Lindemann Maschinenfabrik GmbH v American Hoist and Derrick Co.*, *supra*, 730 F.2d 1452, 221 USPQ 481, 485.

The Office Action must therefore provide a reasonable basis for a rejection of a claim, including asserting that the prior art reference contains the claimed subject matter, with the interrelationships among elements in the reference arranged as in the rejected claim.

Anticipation may not be shown where the general subject matter of the reference is the same, but with a different specific application or use. See *Union Oil Co of Cal. V Atlantic Richfield Co.*, 208 F.3d 989

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The Federal Circuit has ruled that “the prior art reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. *In re Spada*, 911 F.2d 705, 708

3. The Office Action states that “Claims 1-4, 8, 9, and 21-32 are rejected under 35 USC 102(b) as being anticipated by Peterson, et al [US 5,450,063].” (hereinafter “Peterson”). In fact, the Office Action apparently also rejects claims 11 – 16 as anticipated by Peterson, and those additional claims will also be discussed below.

The Office Action ignores the function and purpose of Peterson, and therefore reaches several incorrect conclusions about both the appropriateness of using Peterson as a reference, and what that reference shows, relative to the instant application.

First, Peterson is not a warning device, in the sense that the instant application is. Its purpose is not to warn a person of the presence of the sensed birds, or indeed to warn a person of anything at all. Instead, it is to automatically respond to the presence of migratory birds in the targeted, generally polluted, pond or wetland area, discouraging or frightening away the birds that would otherwise land there. See Peterson, Abstract, and Detailed Description, col 4, lines 22-35. The instant invention, by contrast, has as its purpose warning a

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person of the presence of some dangerous condition, such as a vicious dog, by combining with a written warning sign a visual representation of either the subject vicious dog, or some other attention-getting visual cue, and a similarly attention-grabbing sound, to cause the person to heed the warning sign. "An authentic life-like warning replica of a guard dog face gives realism to the present invention's look and feel. ... The unique nature of the present invention allows for furthering the authenticity of the sign by using a motion detector to activate a sound, such as a dog growl, in conjunction with the eyes and other facial features being illuminated and animal jaw and ears moving at the same time. ... The word 'Beware' or similar would be displayed near the life-like warning replica of an animal. Alternatively, the written warning could be located apart from the depiction. The illuminating eyes would allow for good visibility at night, while the auditory sound would warn visually impaired persons." (page 3, lines 10-27)

Peterson is essentially an extensive and sophisticated electronic scarecrow, to scare off would-be landing birds; by contrast; whereas the instant invention serves to supplement and call attention to a real written warning sign, one that warns people of danger, or the need not to trespass, with increased effectiveness due to its enhanced visual and auditory aids. As previously discussed, the cases require that the prior art reference must disclose each element of the claim "arranged as in the claim." *Lindemann Maschinenfabrik GmbH v American Hoist and Derrick Co.*, supra, 221 USPQ at 485, and that, anticipation is not shown

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where the general subject matter of the reference is the same, but with a different specific application or use. See *Union Oil Co of Cal. V Atlantic Richfield Co*, *supra*. Peterson is so fundamentally different from the instant invention that it cannot properly serve as a reference for purposes of either anticipation or obviousness. Even if it could serve as a reference, it doesn't come close to meeting the cited standards for anticipating the instant invention, as discussed below.

Regarding Claim 1, the Office Action says that all the elements of the instant invention are present in Peterson. That is wrong.

The Office Action asserts that claim 1's "at least one warning sign" is present in Peterson in the flapping wings of its falcon representation, or flapping arms of its mannequin representation. Peterson in fact has no warning sign – the term "warning sign" in the instant application means a literal warning sign -- as discussed above, it is a real sign, with a real message, in words or symbols, intended to be read by the human subject sought to be warned, once his or her attention is captured by the more dynamic visual and auditory features of the device. It is perfectly clear from the description that there is a genuine warning sign, independent of the animal-image warning replica (which is the closest analog to Peterson's flapping predatory bird or mannequin figures): "... the present invention ... allows the warning sign and the warning replica to be



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positioned next to each other or apart from each other, thus creating two separate warnings, and so further increasing the effect on the passer-by or the intruder." In addition, "... the warning sign may warn of one type of danger and the warning replica of an additional danger, thus further increasing the deterring effect." (page 4, lines 17-27) Peterson's flapping wings or arms simply do not constitute a "warning sign."

The Office Action also asserts that both the instant invention's "at least one illumination means" and its "at least one light emitting device" are both present in Peterson. Peterson has the so-called "high intensity lights" 16 and 41, which apparently serve the dual purposes of shining outward, and possibly sweeping the area, and illuminating the falcon or mannequin figures externally. (col 5, lines 37-45 and col 6, lines 42-51) Peterson also has the so-called "visor light" 48, which only shines down the front of the mannequin figure, again lighting it externally in low-light conditions. (col.7. lines 9-14) It is clear that neither of these lighting arrangements contemplates transilluminating either figure type from the inside, whereas the instant invention encompasses "a lighting source ... preferably ... positioned inside the dog head 64 so that it illuminates dog yes [sic, dog eyes] 68 and dog jaw 70. Any color light may be chosen, but red light would be preferred. Illuminating the dog head 64 from inside would have a very dramatic effect on a passer-by who inadvertently approached the alerting device or upon an intruder who did not expect [the] presence of a guard animal or other

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warnings." (page 7, lines 15-20). This is the "light emitting device" of claim 1, and Peterson clearly does not anticipate such an internal lighting feature.

For all these reasons, claim 1 is not anticipated. All the claims in the instant application, and in particular rejected claims 2-4, 8, 9, 11-16, and 21-32, depend from claim 1, and cannot therefore be anticipated by Peterson.

Applicant therefore respectfully requests that the Examiner withdraw the rejection of Claim 1, and of all claims depending from claim 1 that are also asserted to be anticipated by Peterson, *i.e.*, claims 2-4, 8, 9, 11-16 and 21-32.

Regarding claim 2, the Office Action also asserts that the claimed "manual on and off switch" is anticipated by Peterson, which has, "for testing system operation, a remote maintenance bypass switch 72 [that] is preferably provided for use by maintenance personnel to test system operations." col 10, lines 3-6. Peterson goes on to describe that, "in such maintenance testing, data stored in the controller 60 can be displayed at a local data display control unit 75, and can be reduced to hard copy at a local report and statistic printer 76 ... for providing an operator with a record of systems operation." col 10, lines 6-12. In other words, the switch provided in Peterson is solely, as described, a bypass switch, which temporarily decouples the sensing equipment from the controller 60 and the deterrent equipment, for as long as it takes an operator to download data on system operation from the data handling and storage equipment, which remains

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operational throughout, for that purpose. By contrast, the manual on and off switch of the instant invention is just that, a simple on/off switch for powering down the entire alerting device when its operation is not desired. "The motion detector ... will also include a manual on and off switch. This will enable the owner to have the flexibility to turn it off as needed." (page 3, lines 22-23) As such, claim 2 is not anticipated by the differently-functioning bypass switch of Peterson.

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 2, depending from claim 1, cannot be so anticipated. In addition, based upon the immediately preceding discussion, irrespective of the action taken with respect to claim 1, Applicant respectfully requests that the Examiner withdraw the rejection of claim 2 as anticipated by Peterson.

Regarding claim 3, the Office Action asserts that the fact that the "at least one motion detector further comprises a timer" is anticipated by Peterson.

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 3, depending from claim 1, cannot be so anticipated. Applicant respectfully requests that the Examiner withdraw the rejection of claim 3 as anticipated by Peterson.

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Regarding claim 4, that the alerting device is portable, the Office Action apparently asserts that Peterson's system is itself portable, referencing Peterson Figs. 1, 3, and 4. That is incorrect. Figure 1 shows a body of water sought to be covered by Peterson's system, with numerous microwave transmitters and receivers located around the periphery of the pond, forming the microwave "net" which detects the presence of the birds on, or several feet above, the water, and several alarm devices spread around the periphery and/or floating anchored across the surface of the pond, which generate various light and sound disturbances to frighten off birds that land or set up to land on the pond and are detected by the microwave net. (col 4, line 1-col 5, line 9) Figs. 3 and 4 show two different styles of the floating platform alarm devices, one with an elevated figure of a predatory bird, and one with an approximately life-size figure of a person, both with large, sturdy frames and large barrels serving as flotation means.

Together, these devices constitute a massive system spread around and over a large water surface. Even individually, with reference to each of the floating platform alarm devices of Figs. 3 and 4, it is clear that these devices are large, heavy, assemblies. They are at best transportable, as on a large truck, or by a boat towing them into place. They are most certainly not "portable."

By contrast, the instant invention, as is apparent from the figures and description, are roughly the size of an ordinary warning sign, perhaps somewhat

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larger because they are three-dimensional representations, but nevertheless easily carried by a single person – a working definition of “portable.” See page 8, lines 21-22: “Similarly, the alerting device is preferably made portable for ease of relocation from one part of [the] property to another,” something that certainly cannot be said of Peterson’s system. Claim 4 is not anticipated by Peterson.

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 4, depending from claim 1, cannot be so anticipated. In addition, based upon the immediately preceding discussion, irrespective of the action taken with respect to claim 1, claim 4 is not anticipated. Applicant respectfully requests that the Examiner withdraw the rejection of claim 4 as anticipated by Peterson.

Regarding claim 8, the Office Action asserts that “all the claimed subject matters are cited in respect to claim 1.” That is incorrect.

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 8, depending from claim 1, cannot be so anticipated. In addition, as is also discussed above with respect to claim 1, Peterson has no warning sign, and cannot for that reason anticipate claim 8. Accordingly, irrespective of the action taken with respect to claim 1, Applicant respectfully requests that the Examiner withdraw the rejection of claim 8 as anticipated by Peterson.

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Regarding claim 9 ("wherein said prerecorded message comprises a siren sound, a buzzing sound, a bell, a horn, a gun shot, a shriek, yell, shout, scresm [sic, scream], musical notes, an animal sound, a dog growl, words of warning, specific announcement, and a dog bark"), the Office Action asserts that "all the claimed subject matters are cited in respect to claim 1 above. That is not correct.

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 9, depending from claim 1, cannot be so anticipated. Applicant respectfully requests that the Examiner withdraw the rejection of claim 9.

Regarding claim 11, the adjustability of the illumination provided on the at least one warning replica under varying lighting conditions, the Office Action asserts that it is anticipated because "the high intensity of illuminating light 48 is changed according to the no or low light conditions." That is incorrect. The cited language from Peterson (col. 7, lines 8-14, says only that, "Preferably, for further attracting a bird's attention during no or low light conditions, each mannequin 45 can be equipped with a visor light 48, that is preferably located in the center of their forehead to shine downwardly therefrom, illuminating the mannequin and its flailing arms." In other words, in poor or variable ambient light conditions, it is advantageous to have the mannequin illuminated by a visor light – but there is no indication that that illumination is itself variable. Claim 11 specifically contemplates that the illumination of the warning replica should itself be variable

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illumination, to deal with the differing natural light conditions. Claim 11 is therefore not anticipated by Peterson.

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 11, depending from claim 1, cannot be so anticipated. In addition, based upon the immediately preceding discussion, irrespective of the action taken with respect to claim 1, Applicant respectfully requests that the Examiner withdraw the rejection of claim 11 as anticipated by Peterson.

Regarding claim 12, that, "the claimed at least one warning replica is positioned in the space defined by the at least one warning sign," the Office Action asserts that Peterson anticipates by virtue of having the replica falcon and the mannequin. As discussed with respect to claim 1, Peterson's device has no warning sign at all, and therefore cannot have its warning replicas, or as close as it has to warning replicas, positioned in the space defined by its nonexistent warning sign.

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 12, depending from claim 1, cannot be so anticipated. In addition, based upon the immediately preceding discussion, irrespective of the action taken with respect to claim 1, Applicant respectfully requests that the Examiner withdraw the rejection of claim 12 as anticipated by Peterson.

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Regarding claim 13, that "the claimed at least one warning replica is positioned in the space beyond the space defined by the at least one warning sign," again, as discussed with respect to claims 1 and 12, Peterson has no warning sign, and therefore cannot have a warning replica beyond the space defined by a nonexistent warning sign, and cannot anticipate claim 13

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 13, depending from claim 1, cannot be so anticipated. In addition, based upon the immediately preceding discussion, irrespective of the action taken with respect to claim 1, Applicant respectfully requests that the Examiner withdraw the rejection of claim 13 as anticipated by Peterson.

Regarding claim 14, that "said at least one warning replica comprises at least one of: animal face, animal profile, animal head, a partial animal body, a complete animal body, an animal or human skull, bones, skeleton, police car, flashing lights of a police car, and any attention drawing subject," the Office Action asserts that "all the claimed subject matters are cited in respect to claim 1." That is incorrect. Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 14, depending from claim 1, cannot be so anticipated. Applicant respectfully requests that the Examiner withdraw the rejection of claim 14 as anticipated by Peterson.



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Regarding claim 16, that the animal face or body of claim 14 comprises at least on[e] face, head, or body of a dog, wolf, tiger, lion, leopard, cheetah, hyena and other vicious animal, the Office Action asserts that the claim "reads upon the replica falcon 36, see Fig. 3" of Peterson. That is incorrect. Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 15, depending from claim 14, depending from claim 1, cannot be so anticipated. Applicant respectfully requests that the Examiner withdraw the rejection of claim 15 as anticipated by Peterson.

Regarding claim 16, that the claimed animal face, animal profile, animal head, animal body further comprise a movable portion, the movable portion being capable of changing its position contemporaneously or sequentially with the prerecorded message" the Office Action asserts that it is anticipated by Peterson's ability to flap the movable wings of their replica hawk along with recorded sounds, or to move the arms of their mannequin along with playing the sound of a gunshot. Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 16, depending from claim 1, cannot be so anticipated. Applicant respectfully requests that the Examiner withdraw the rejection of claim 16 as anticipated by Peterson.

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Regarding claim 21, that "said one warning replica is made of weather resistant material," the Office Action asserts that the claim is anticipated by Peterson's observation that their "floating platforms and displays thereon are preferably manufactured from non-reactive materials, such as a plastic, or the like," and that certain of the components "can be manufactured from reinforced fiberglass, and the drums are preferably ... foam filled polyvinyl chloride," but that "other non-reactive materials could be so used." (col 7, lines 33-35). Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 21, depending from claim 1, cannot be so anticipated. Applicant respectfully requests that the Examiner withdraw the rejection of claim 21 as anticipated by Peterson.

Regarding claim 22, "wherein said weather resistant material is high-density molded plastic," the Office Action asserts that Peterson anticipates, based on the same statements quoted above in discussing claim 21. Peterson does not specifically anticipate use of high-density molded plastic, which constitutes a significant improvement in weather-resistance over just specifying "a plastic" or "reinforced fiberglass" or "other non-reactive materials" for the figures on the floats, which are the parts analogous to the warning replicas of the instant invention. Claim 22 is not therefore anticipated.

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Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 22, depending from claim 1, cannot be so anticipated. In addition, based upon the immediately preceding discussion, irrespective of the action taken with respect to claim 1, Applicant respectfully requests that the Examiner withdraw the rejection of claim 22 as anticipated by Peterson.

Regarding claim 23, "wherein said high density plastic is Teflon," the Office Action again asserts that the claim is anticipated by the same quoted material from Peterson as discussed with respect to claims 21 and 22, above. Peterson, which, as discussed above, does not anticipate the use of high-density molded plastic, certainly does not anticipate the even more advantageous use of TEFLON ®, an exceptionally nonreactive material, for increased weather-resistance of the warning sign and warning replica of the instant invention. Claim 23 is not anticipated.

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 23, depending from claim 1, cannot be so anticipated. In addition, based upon the immediately preceding discussion, irrespective of the action taken with respect to claim 1, Applicant respectfully requests that the Examiner withdraw the rejection of claim 23 as anticipated by Peterson.

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Regarding claim 24, the Office Action asserts that "the claimed light emitting device is position [sic, positioned] in the interior of the at least one warning replica. (the visor light 48, see Fig. 4)." That is incorrect. Peterson's visor light is designed to illuminate only the exterior of the figure. As discussed with respect to claim 11, above, the description of Peterson's visor light (at col. 7, lines 8-14) states that, "... each mannequin 45 can be equipped with a visor light 48, that is preferably located in the center of their forehead to shine downwardly therefrom, illuminating the mannequin and its flailing arms." By contrast, the instant invention's claimed light emitting device "would preferably be positioned inside the dog head 64, so that it illuminates the dog yes [sic, eyes] 68 and dog jaw 70 ... Illuminating the dog head from inside would have a very dramatic effect on a passer-by who inadvertently approached the alerting device or upon an intruder who did not expect presence of a guard dog or other warnings." (see application, page 7, lines 15-20.) This transillumination feature is not anticipated by Peterson.

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 24 depending from claim 1, cannot be so anticipated. In addition, based upon the immediately preceding discussion, irrespective of the action taken with respect to claim 1, Applicant respectfully requests that the Examiner withdraw the rejection of claim 24 as anticipated by Peterson.

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Regarding claim 25, the Office Action asserts that the claimed at least one light emitting device comprising ultraviolet, blue, yellow, orange, green, and red colors is anticipated by Peterson's "high intensity lights, strobe lights, or the like [which] may be filtered to project primary colors as the birds see and are sensitive to." (col 5, lines 37-39).

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 25, depending from claim 1, cannot be so anticipated. Also, for the reasons discussed with respect to claim 24, that claim, from which claim 25 directly depends, is not anticipated by Peterson, so claim 25, depending from claim 1, cannot be so anticipated, irrespective of the action taken with respect to claim 1. Applicant respectfully requests that the Examiner withdraw the rejection of claim 25 as anticipated by Peterson.

Regarding claim 26, the Office Action asserts that the claimed at least one light emitting device being capable of intermittent operation is anticipated by Peterson's flashing strobe lights. Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 26, depending from claim 1, cannot be so anticipated. Applicant respectfully requests that the Examiner withdraw the rejection of claim 26 as anticipated by Peterson.

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Regarding claim 27, the Office Action asserts that the claimed motion detector, announcement device, warning replica, and light emitting device being an integral unit is anticipated by Peterson, citing Peterson's Fig. 4. It is not. As discussed at page 5, lines 22-24, "The motion detector 26, the switch 22, the announcement device 30, the warning sign 24, [and] the warning replica 28 may all be integrated in one unit, such as the device 60 in Fig. 2,..." An examination of Fig. 2 makes it clear that the phrase "integrated in one unit" means that all the elements are located within the confines of a single, portable, combined warning sign and warning replica. Peterson's enormous floating platform shown in its Fig. 4 simply does not integrate all its elements, in the sense that the claimed invention does, into such a self-contained and compact single device.

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 27, depending from claim 1, cannot be so anticipated. In addition, based upon the immediately preceding discussion, irrespective of the action taken with respect to claim 1, Applicant respectfully requests that the Examiner withdraw the rejection of claim 27 as anticipated by Peterson.

Regarding claim 28, the Office Action asserts that the claimed motion detector, announcement device, warning replica, and light emitting device not being an integral unit, is anticipated by Peterson, citing Peterson's Fig. 3. This is mystifying, since Fig. 3 seems to be no more or less integrated than Fig. 4, which

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is cited against claim 27, above, as having all the elements integrated. In fact, as discussed above, neither is integrated in the sense of claim 27.

In any event, since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 28, depending from claim 1, cannot be so anticipated. Applicant respectfully requests that the Examiner withdraw the rejection of claim 27 as anticipated by Peterson.

Regarding claim 29, the Office Action asserts that the claimed transmitting means comprising hard-wiring, a fiber-optic connection, or wireless transmission, is anticipated by Peterson, citing Fig. 6 for the proposition that it shows hardwiring for that transmitting means.

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 29, depending from claim 1, cannot be so anticipated. Applicant respectfully requests that the Examiner withdraw the rejection of claim 29 as anticipated by Peterson.

Regarding claim 30, the Office Action asserts that the claimed warning sign's warning of the presence of the same animal as the depiction (or warning replica), is anticipated by Peterson, citing Fig.3, which shows a replica of a bird of prey scaring off the subject migratory water birds. In no way is this equivalent to claim 30.

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First, as discussed with respect to claim 1, Peterson's devices have no warning sign at all, in the sense of a message to be read by a person to warn of a danger or a trespass. They perform no "warning" function as such at all -- Peterson has moving elements designed to frighten away migratory birds, not to alert anyone to their presence, even were they themselves dangerous. Second, using a replica of, for example, a vicious dog, to warn a person of the presence of a vicious dog, in the manner contemplated by claim 30, bears no resemblance to using a replica of a hawk to scare away waterfowl. Both are birds, but there the resemblance ends -- the predatory hawk is used not because it is the same as the waterfowl (both birds), but because it is different from them (predator versus prey), and terrifying to them. And, again, nothing and no one is being "warned" of the waterfowl's presence.

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 30, depending from claim 1, cannot be so anticipated. In addition, based upon the immediately preceding discussion, irrespective of the action taken with respect to claim 1, Applicant respectfully requests that the Examiner withdraw the rejection of claim 30 as anticipated by Peterson.

Regarding claim 31, the Office Action asserts that the claimed warning sign's warning of the presence of an animal different from the depiction (warning



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replica), is anticipated by Peterson, citing Fig. 4, which shows a mannequin (replica human) used to scare away migratory birds.

First, as discussed with respect to claim 1, Peterson's devices have no warning sign at all, in the sense of a message to be read by a person to warn of a danger or a trespass. They perform no warning function as such at all -- Peterson has moving elements designed to frighten away migratory birds, not to alert anyone to their presence. Neither claim 30's hawk image nor claim 31's human image exists to "warn" anyone of the presence of the migratory waterfowl, which do not represent a danger to anyone (but perhaps themselves) or a trespass on the protected area, but simply to frighten away the water birds, to protect them. Their purpose is completely different from that of the current invention.

Again, since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 31, depending from claim 1, cannot be so anticipated. In addition, based upon the immediately preceding discussion, irrespective of the action taken with respect to claim 1, Applicant respectfully requests that the Examiner withdraw the rejection of claim 31 as anticipated by Peterson.

Regarding claim 32, the Office Action asserts that the warning sign's warning of the presence of a dog comprising a watch dog, German Shepard, Doberman, and Rottwieller, is anticipated by Peterson's because it "reads upon

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the dogs barking,” which is one of the “bird thwarting” sounds Peterson uses to scare away migratory birds. (No citation is given, but see col 5, lines 21-24.)

First, as stated many times, Peterson has no warning signs. Nothing about Peterson’s device “warns of the presence of” anything, let alone a dog. It is an electronic scarecrow, intended to frighten off birds that might otherwise land near it, using, among other “bird thwarting sounds,” that of a dog barking. This simply bears no relation to the instant invention’s using variously configured warning signs and warning replicas to warn a human of the presence of one of the named breeds of dog.

Since, as discussed at length above, claim 1 is not anticipated by Peterson, claim 32, depending from claim 1, cannot be so anticipated. In addition, based upon the immediately preceding discussion, irrespective of the action taken with respect to claim 1, Applicant respectfully requests that the Examiner withdraw the rejection of claim 32 as anticipated by Peterson.

#### **Claim Rejections – 35 USC § 103**

Relying on MPEP (8th Edition) 706.02(j)(A)(B)(C)(D) and the following cases for standards of obviousness, to establish the *prima facie* case of obviousness, the following basic criteria need to be met:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of the

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ordinary skill in the art, to modify the reference or to combine the references' teachings.

Second, there must be a reasonable expectation of success.

Third, the prior art reference (or references when combined) must teach all the claim limitations.

Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. (Citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed Cir 1991), (emphasis added).

In addition, the reference must be either in the field of the inventor's endeavor or reasonably pertinent to the specific problem with which the inventor was involved. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986)

"A reference is reasonably pertinent if ...it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering the problem....If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem...if it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

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Finally, the Federal Circuit has added the following when determining whether the reference is within the inventor's endeavor:

"We have reminded ourselves and the PTO that it is necessary to consider 'the reality of circumstances' – in other words, common sense – in deciding in which field a person of ordinary skill would reasonably be expected to look for solution to the problem facing the inventor." *In re Oetiker*, 977F.2d 1443, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992, quoting *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)

4. The Office Action purports to reject Claims 5-7 as unpatentable over Peterson in view of Baldwin, et al, US 5,971 597. However, the Office Action then proceeds to discuss combining Peterson not with Baldwin, et al, but instead with Yu, US 5,726,629, which is cited in Applicant's IDS. The discussion only makes sense if the reference is in fact to Yu. Applicant will respond on that basis.

The Office Action fails to make a prima facie case of obviousness of these claims.

First, as was discussed with respect to the asserted anticipation of claim 1 by Peterson, elements of claim 1, from which claims 5-7 depend, are missing from Peterson, notably the warning sign. This element is not provided by Yu, so

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claims 5-7 cannot be rendered obvious by combining those two references, even if it were permissible to combine them. On that ground alone, Applicant requests that the rejection of claims 5-7 as rendered obvious by Peterson in view of Yu be withdrawn.

Second, it is in fact not permissible to combine these references, there being no suggestion or motivation in the references to combine these fundamentally dissimilar references. Peterson is a large-scale radar or microwave-based electronic net, intended to detect and automatically frighten migratory birds away from bodies of water that might be unhealthy for them. Yu is essentially a porchlight with a motion detector that triggers the playing of an audio message. (See abstracts of both references.) There is no suggestion in either reference to combine them. The suggestion made by the Office Action that a person of ordinary skill in the art involved in designing the large scale "bird avert" system of Peterson would be motivated to replace Peterson's radar or microwave motion detection system with the IR or ultrasonic motion detector of Yu, "for reducing and/or eliminating of electromagnetic interference with other radio electronic devices/equipment within the area while still providing effectively detecting motions of animals, birds and/or human intrusion" is rank speculation. There is no suggestion in either reference, and no reason to believe, that the cited interference "problem" that could ostensibly be solved by making such a substitution, actually exists in system operation, or that the IR or ultrasonic

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motion detection schemes used in Yu's light fixture, to detect motion a few feet away, would work in Peterson's situation, attempting to cover with an electronic net, and at a selected distance above the water surface, an enormous stretch of water or wetlands. (See Peterson, col 2, lines 29-27)

It being improper to combine Peterson and Yu, Applicant respectfully requests for that reason as well that the rejection of claims 5-7 as rendered obvious by Peterson in view of Yu be withdrawn.

Specifically regarding claim 5, the Office Action admits that that the claimed motion detector being a light beam motion detector is not met by Peterson, which uses microwave or radar motion detectors (col 4, lines 1-4, 63-68, but asserts that "an artisan would substitute either the IR [infrared] or ultrasonic sensor of Yu for reducing and/or eliminating of electromagnetic interference with other radio devices/equipment within the area while still providing effectively detecting motions of animals, birds, and/or human intrusion."

There is no suggestion in either Peterson or Yu that such a substitution of a light beam motion detector for Peterson's microwave or radar motion detector could or should be made, or that the use of Peterson's microwave or radar detectors is disadvantageous, either for the reason posited by the Office Action, or for any other reason. There is therefore no proper basis for combining these two references, and no prima facie case of obviousness of this claim.

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Regarding claim 6, the Office Action asserts that "the claimed light beam motion detector [being] an infrared detector is met by the combination between Peterson et al and Yu in respect to claim 5, above.

As discussed above, elements of claim 1, from which claim 5 depends, are absent from both Peterson and Yu, and are therefor absent from the combination of those references, even were it proper to combine them. As also discussed above, it is impermissible to combine them. For both reasons, there is not a prima facie case for obviousness of claim 6.

Regarding claim 7, the Office Action asserts that, "the claimed at least one motion detector [being] an ultrasonic is met by the combination of the ultrasonic detector between Peterson et al and Yu in respect to claim 5 above."

For precisely the same reasons as discussed above with respect to all three claims, 5, 6, and 7 in common, and individually with respect to claims 5 and 6, above, there is not a prima facie case of obviousness of claim 7.

Accordingly, Applicant again respectfully requests that the rejection of claims 5-7 as unpatentable over Peterson in view of Yu be withdrawn.

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5. Claim 10 is rejected as being unpatentable over Peterson, in view of Reich [US 5,892,446].

First, as was discussed with respect to the asserted anticipation of claim 1 by Peterson, elements of claim 1, from which claim 10 depends, are missing from Peterson, notably the warning sign. These elements are not provided by Reich, so claim 10 cannot be rendered obvious by combining those two references, even were it permissible to combine them.

Second, it is not permissible to combine these references, there being no suggestion or motivation in the references to combine them when attempting to solve the problem addressed by the instant invention, the need to effectively warn people of the presence of a dangerous situation, such as the presence of a vicious dog, or of a trespass. Reich, like Peterson, is simply an electronic scarecrow. Its purpose, like Peterson's, is fundamentally different from that of the instant invention -- not to warn any person of anything, but just to scare off some animals. There would be no reason to combine these two animal deterrent devices in searching for a way to solve the different problems addressed by the instant warning device. There is no prima facie case for obviousness of claim 10.

Accordingly, Applicant respectfully requests that the rejection of claim 10 as unpatentable over Peterson in view of Reich be withdrawn.



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6. Claims 17-20 are rejected as being unpatentable over Peterson alone.

First, as was discussed with respect to the asserted anticipation of claim 1 by Peterson, several elements of claim 1, from which claims 17-20 depend, are missing from Peterson, notably the warning sign and the light emitting device. There is no claim, nor could there be, that these missing elements are simply obvious design choices. Their absence from Peterson (quite aside from those features added by dependent claims 17-20, which are admitted to be absent from Peterson) means that it is impossible to find those claims unpatentable over Peterson alone. Additional argumentation with respect to the elements added by each of those claims follows.

Regarding claim 17, the Office Action asserts that, although Peterson does not disclose the movable portion [of the animal face, animal profile, animal head, or animal body of claim 16] comprises ears and jaw of the animal, with the jaw being capable of opening and closing movements, " it is merely "a design choice to make the jaw of the mannequin to move according to the recorded human voice for scaring the birds."

This fails to state a prima facie case of obviousness for claim 17. Peterson contains no suggestion of the moving jaw innovation of claim 17, and no specific motivation is shown for Peterson to have done that which it did not do. See *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089, at 1094, which requires a

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showing that a specific feature is a matter of "design choice" and therefore obvious.

Accordingly, Applicant respectfully requests that the rejection of claim 17 as unpatentable over Peterson alone be withdrawn.

Regarding claim 18, the Office Action asserts that, although Peterson does not disclose the movable jaw [of claim 17] further comprising at least one tooth and a tongue, it is nevertheless obvious because, "it would have been obvious to an artisan to create the at least one tooth and a tongue for the mannequin for greater human look alike [sic], which provides a greater effective of scaring the birds [sic]."

This fails to state a prima facie case for obviousness. It amounts to a naked assertion that a person of ordinary skill in the art would have modified Peterson, which is intended to scare birds with a moving human mannequin, by adding to the mannequin the movable jaw with a tooth and a tongue of claim 18 (apparently to more effectively scare the birds by making the device look more human!), and would thereby arrive at the instant invention's portrayal of a vicious animal, intended to startle and get the attention of a human intruder. No evidence whatever is offered for this leap, and it plainly makes no sense.

Accordingly, Applicant respectfully requests that the rejection of claim 18 as unpatentable over Peterson alone be withdrawn.

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Regarding claim 19, the Office Action asserts that the claimed movable portion (of claim 16) being detachably connected to the animal face, profile, head, or body, is rendered obvious by (apparently – the sentence is badly garbled) the fact that Peterson's flapping wings on the falcon replica, or flapping arms on the mannequin, "could be detached or disassembled from the falcon or mannequin since they are mechanical assembling [sic, mechanically assembled?] for providing motions."

The Office Action fails to state a prima facie case for obviousness of this feature of the instant invention. There is no evidence whatever in the cited description or figures that the wings/arms of Peterson's devices are mechanically coupled to the bodies in a manner that makes it obvious to modify Peterson so as to have them remain detachable from the bodies, let alone that such would be obvious in designing the fundamentally different movable portion of the instant invention.

Accordingly, Applicant respectfully requests that the rejection of claim 19 as unpatentable over Peterson alone be withdrawn.

Regarding claim 20, the Office Action asserts that having the movable portion (of claim 16) be an integral part of the warning replica is obvious, with no evidence or explanation whatever, only a citation to the two figures showing Peterson's replica falcon and its mannequin, neither of which sheds any light at

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all on how their respective movable appendages are attached, or whether they are integral with the bodies. If anything, it is perhaps more likely that they are not integral with the bodies, since they are described in the written description as the wings being "pivotally connected to and extending outwardly from the bird shoulders" (col 6 , lines 30-34), and the arms being "pivotally connected to the mannequin shoulders" (col 7 , lines 3-4) of Peterson's electronic scarecrow. In either event, there is no evidence that the connection of these appendages in Peterson would make it obvious to make the movable portion of the very different warning replica of the instant invention integral with the replica's animal face, profile, head, or body. The Office Action therefore fails to state a prima facie case for finding this feature obvious.

Accordingly, Applicant respectfully requests that the rejection of claim 20 as unpatentable over Peterson alone be withdrawn.

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### Conclusion

In view of the information provided above, Applicant respectfully requests that the rejection of claims 1-32 be withdrawn, and that the amendments to claims 1, 7, 9, 10, 15, 20, 23, 25, 29, 30, 31, and 32 be entered, and the application passed to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Barton A. Smith". The signature is written in a cursive, flowing style.

Barton A. Smith  
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**Amendments to the Drawings**

None.